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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/657,394 | 09/08/2003 | William J. Mertz | 1248 P 122 | 9357 |

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| EXAMINER | |
|---|---|
| MOORE, MARGARET G | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1712 | |

DATE MAILED: 11/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/657,394 | MERTZ ET AL. | |
| | Examiner | Art Unit | |
| | Margaret G. Moore | 1712 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *17 October 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1 to 11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 to 11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. Please note that the examination of this application has been transferred. Currently this application is being examined by Margaret Moore. The Examiner has, essentially, restarted prosecution in view of the new ground of rejections noted below. The Examiner apologizes for this extension in prosecution.

2. Applicants and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application. Applicants are requested to provide a determination of the silicone extractables for the instant release liner in terms of percent extractables. This is believed to be readily obtainable for applicants since page 9 of the specification states that the test determines percent extractables *or* the units of micrograms of silicone per square inch. This is reasonably necessary to the examination of the application because the Examiner cannot find any prior art reference that measures silicone extractables in terms of micrograms per square centimeter. Most references determine silicone extractables by percent extractable (see col. 9, line 20 of Leman, col. 10, line 51 of Griswold, col. 22, line 14 of Scholz et al., col 4, line 67 of Roth). Also the Examiner cannot find any mention of or reference to the Rexam Release RTM Number 83 test. This makes it difficult for the Examiner to compare the instant claims with the prior art.

3. Claims 1 to 12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The limitation regarding total extractable content in the release liner is confusing since one cannot determine the extractable content in a *curable* coating. That is, the coating composition must be cured for the total extractables to be determined. This may seem like a technicality but as claimed the release coating is not cured and will still be present in an organic solvent. From the specification and the arguments provided by applicants from previous responses, the intent is that the release liner is, in fact, cured and the organic solvent is removed. This is how the present examiner will consider the

claims, but she notes that this is not what is actually claimed. Along these lines, note the reference to "said radiation cured release coating" in claim 7 lacks antecedent basis. Also, for claim 6, it is unclear how the total uncured silicone transfer content can be limited when all of the silicone, as claimed, is uncured.

For claim 8, it is unclear if this limitation refers to total silicone extractables or the total of all extractables.

4. As noted above the Examiner has been unable to find a teaching or reference to the silicone extractable content as claimed. Thus in an effort to determine the breadth of the claims the Examiner will consider them in view of the process by which the release liner is made. For instance, in the most recent remarks provided by applicants they indicate that it is a combination of the coating composition (a silicone release coating absent a silicone hydride in an organic solvent) and the process by which the liner is prepared (heating followed by UV cure) that results in the silicone extractable content. See for instance the top of page 5 of applicants' remarks as well as paragraph 7 of the declaration filed 5/2/05. The rejection below is based upon this interpretation of the claims. The Examiner notes that the instant claims are not in product by process format, but applicants argue the limitation is such a manner and the Examiner will consider them in such a manner.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 1 to 11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Leir et al. '356.

Leir et al. teach a cationically co-curable polysiloxane release composition. See for instance the general formula I in the abstract. This meets the claimed silicone release composition. Particular attention is drawn to Example 35 on column 17, in which a silicone release composition, in the presence of an organic solvent and absent a silicone hydride, is applied as a release coating. The coated film is then heat treated to a temperature of 54 °C (within the heating range argued by applicants on page 5 of the remarks). This composition is then cured by exposure to radiation. Thus the coating composition in Leir et al. and the process of making the release liner is the same as that argued by applicants. Patentees fail to teach the total silicone extractable content.

Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. Please note MPEP 2113, which addresses the appropriateness of a rejection under 35 USC 102/103 for product by process claims. In the alternative, where applicants claim a composition in terms of a function, property or characteristic and the composition of the prior art is the same as that of the claim but the function is not explicitly disclosed by the reference, the examiner may make a rejection under both 35 U.S.C. 102 and 103, expressed as a 102/103 rejection. See MPEP 2112 (III).

For claims 9 to 11, see the bottom of column 9 through column 10. Also, for claim 7, note that the silicone release layer can be applied to "at least one major surface" of a material, indicating that the layer can, in fact, be applied to two surfaces of the material.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
11/8/05